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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,387	02/02/2001	Stanley N. Protigal	2898.2US (88-070.7)	2208
24247	7590	12/22/2003	EXAMINER	
TRASK BRITT			SEFER, AHMED N	
P.O. BOX 2550			ART UNIT	PAPER NUMBER
SALT LAKE CITY, UT 84110			2826	

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/776,387	<b>Applicant(s)</b> PROTIGAL ET AL.	
	<b>Examiner</b> A. Sefer	<b>Art Unit</b> 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on October 02, 2003 has been entered and claims 1, 2, 6, 7 have been cancelled.

### ***Allowable Subject Matter***

2. The indicated allowability of claims 3-5 and 8-10 is withdrawn in view of the newly discovered reference(s) to Simko USPN 4,533,846. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 5 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "the capacitor includes a first node and a second node, one node comprising a poly layer and the other node comprising a channel" recited in claims 5 and 10 is not disclosed in the specification to enable one skilled in the art to make and/or use the invention. Without this information it would take undue experimentation to make and use the claimed invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Simko USPN 4,533,846.

Simko discloses (see figs. 1 and 2 and col. 2, lines 40-67) a semiconductor device for operable connection to a carrier substrate, the semiconductor device comprising a regulator circuit T1 for receiving an electrical power signal; a semiconductor substrate 12; active circuit devices T2/T3 formed the semiconductor substrate; and an on-chip capacitor C having at least a portion thereof formed in active area of the semiconductor substrate or an on-chip capacitor C comprising a planar type capacitor (as in claim 4) having at least a portion thereof formed in active area of the semiconductor substrate, the on-chip capacitor being operably coupled to the regulator circuit and operably coupled to the active circuit devices.

As for claims 5, as understood, Simko discloses a first node and a second node, one node V2 comprising a poly layer 24 and the other node Vo comprising a channel.

7. Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Simko USPN 4,533,846.

Simko discloses (see figs. 1 and 2 and col. 2, lines 40-67) a semiconductor device for connection to a carrier substrate configured to provide power and ground thereto, the semiconductor device comprising a semiconductor substrate 12 having active circuit elements

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T2/T3 formed on an active area thereof; at least one regulator circuit T1 for receiving power; and at least one capacitor C on the semiconductor substrate comprising a planar type capacitor (as in claim 9), at least a portion of the at least one capacitor being formed on the active area, the at least one capacitor being operably coupled to the at least one regulator circuit and to the active circuit elements.

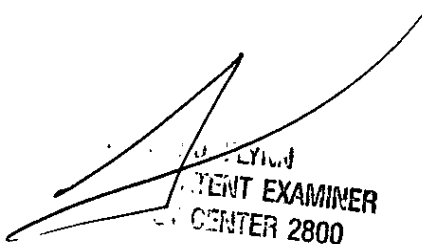
As for claim 10, as understood, Simko discloses a first node and a second node, one node V2 comprising a poly layer 24 and the other node Vo comprising a channel.

As for providing filtering capacitance for the semiconductor device recited in the claims 3 and 8, a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Sefer whose telephone number is (703) 605-1227.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (703) 308-6601.

ANS  
December 12, 2003

  
PATENT EXAMINER  
CENTER 2800